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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,371	04/02/2004	Matthias Loeffler	2003DE417	2598

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1713

MAIL DATE.	DELIVERY MODE
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06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,371

Applicant(s)

LOEFFLER ET AL.

Examiner

Michael Bernshteyn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on March 20, 2007. Claim 1 has been amended; claim 17 has been cancelled; no claims have been added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 20, 2007 has been entered.
3. Claims 1-8 and 10-16 are pending.

Claim Rejections - 35 USC § 102

4. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 1-8 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Loffler et al. al. (U. S. Patent Application Publication 2001/0029287, now U. S. Patent 6,437,068), for the rationale recited in paragraph 3 of Office Action dated on March 8, 2006, and comments below.

Response to Arguments

6. Applicants traverse the rejection of claims 1-8 and 10-16 under 35 U.S.C. 102(b)/103(a) as being anticipated by Loffler et al. al. (U. S. Patent Application

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Publication 2001/0029287, now U. S. Patent 6,437,068). Applicant's arguments have been fully considered but they are not persuasive.

7. Applicants contend that the prior art does not teach, disclose or suggest element B), "adding a higher-boiling solvent, or solvent mixture, one or more emulsifiers and mixtures thereof to the mixture of polymer and polymerization medium, where the boiling point of the higher-boiling solvent or solvent mixture is at least 10°C higher than that of the polymerization medium used for the polymerization," of amended Claim 1. Furthermore, the prior art does not provide the motivation necessary for an obviousness rejection under 103(a), to modify Loeffler et al. in a manner as proffered by the Office (page 6, the bridging paragraph).

8. It is noted that the rejection was made under 35 U.S.C. 102(b) as being anticipated by Loffler et al. al. (U. S. Patent 6,437,068), not under 35 U.S.C. 102(b)/103(a), as mistakenly Applicants argue. Therefore, there is no need for any motivation necessary for an obviousness rejection under 35 U.S.C. 103(a).

Furthermore, it is worth to mention that Loffer fully discloses the limitations of claim 1 (step III B), concerning adding of a higher-boiling solvent or solvent mixture and one or more emulsifiers to the mixture of polymer and polymerization medium, and the limitations of claims 15 and 16, because most of the species in the prior art are correspondingly exactly the same as in instant claims 15 and 16 (compare instant claims 15 and 16, which describe in details all possible species for the higher-boiling solvent or solvent mixture, and US'287, pages 3-4, [0035]). The only difference

concerns the used terminology: the prior art is silent about a **higher-boiling solvent** and named these species as **oil substances**.

With regard to the limitations of step III B in claim 1, Loffler discloses that the adding of a higher-boiling solvent or solvent mixture and one or more emulsifiers to the mixture of polymer and polymerization medium is the next step after the formation of polymer of high molecular weight. Practically it can be done when the reflux condenser is replaced by a distillation bridge (compare the specification, example A, pages 11-12, [0034] and US'287, Example 1, page 3, [0024] and Examples 1-4 O/W cream, pages 4-5, [0042]-[0060]).

Therefore, in view of substantially identical method of free radical polymerization, and used the same structural units of a) and b) in the copolymer, initiators, crosslinkers, emulsifiers,, solvents (tert-butanol), temperatures, duration of the reaction, etc. between Loffler and instant claims, and used for the same purposes for cosmetic, pharmaceutical and dermatological oil-in-water emulsion compositions, it is the examiner position that Loffler's process does not necessarily different from the instantly claimed process.

9. In the light of the discussion above, the rejection of record has not been withdrawn. The rejection remains in force.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Examiner
Art Unit 1713

MB
05/25/2007



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700